

This Opinion is Not a
Precedent of the TTAB

Mailed: November 13, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Rodeowave Entertainment, LLC
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Serial No. 87801076
—

Amy J. Everhart of Everhart Law Firm, PLC,
for Rodeowave Entertainment, LLC.

Leslee A. Friedman, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

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Before Thurmon, Deputy Chief Administrative Trademark Judge,
Lykos and English, Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Rodeowave Entertainment, LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark JUST ANOTHER DAY IN PARADISE for:¹

- “Candles” in International Class 4;
- “Flatware, namely, forks, knives, and spoons” in International Class 8;
- “Lamp shades; Lamps; Lamps for festive decoration; Lamps for outdoor use; Portable fire pits” in International Class 11;

¹ Application Serial No. 87801076; filed February 16, 2018.

- “Art prints; Book ends; Coasters made of paper; Coasters of cardboard; Posters; Wall decals” in International Class 16;
- “Pillows; Furniture, mirrors, picture frames” in International Class 20;
- “Bottle openers; Candle holders; Coasters, not of paper or textile; Dinnerware; Insulating sleeve holder for beverage cups; Insulating sleeve holder for bottles; Insulating sleeve holders for beverage cans; Margarita glasses; Pitchers; Pot holders; Salt and pepper shakers; Trivets; Wine glasses; Beer mugs; Beverage glassware; Cups and mugs; Dishes and plates; Drinking straws; Drinking glasses, namely, tumblers; Leather coasters; Non-electric portable beverage coolers; Pillar candle plates; Plastic coasters; Portable coolers, non-electric; Votive candle holders” in International Class 21;
- “Bed and table linen, wall hangings of textile; Bed blankets; Bed covers; Bed sheets; Bed skirts; Bed spreads; Bed throws; Pillow cases; Pillow covers; Towels” in International Class 24;
- “Decorative wall hangings, not of textile; Rugs” in International Class 27; and
- “Christmas tree ornaments and decorations” in International Class 28.

The application is based on an allegation of an intent to use the mark under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney refused registration under Sections 1, 2, and 45 of the Trademark Act U.S.C. §§ 1051-52 and 1127, on the ground that the applied-for-mark fails to function as a trademark “because the wording constitutes a common slogan widely used in the marketplace.”² When the refusal was made final, Applicant

² Examining Attorney’s Brief, 10 TTABVUE 3. The Examining Attorney also cites Section 3 of the Trademark Act, 15 U.S.C. § 1053, as a basis for refusal, but that section of the Act applies to services and is inapplicable to the application here, which covers only goods.

Citations to the prosecution record are to the Trademark Status & Document Retrieval (“TSDR”) system by page number in the downloadable .pdf versions of the documents. All other citations are to TTABVUE, the Board’s online docketing system.

appealed and requested reconsideration. The Examining Attorney denied Applicant's request for reconsideration, and the appeal was resumed. We reverse the refusal to register.

I. Analysis

“The Trade-Mark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration.” *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960). Section 45 of the Trademark Act defines a “trademark” as “any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127. *See also In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976) (“[T]he classic function of a trademark is to point out distinctively the origin of the goods to which it is attached”). “[N]ot every designation that is placed or used on or in connection with a product necessarily functions ... as a trademark for said product; not every designation adopted with the intention that it performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose; and there are certain designations that are inherently incapable of functioning as trademarks to identify and distinguish the source of the products in connection with which they are used.” *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013) (quoting *American Velcro, Inc. v. Charles Mayer Studios, Inc.*, 117 USPQ 149, 154 (TTAB 1973)).

“Slogans and other items that are considered to be merely informational in nature, or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry, are not registrable.” *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (affirming refusal to register “Once a Marine, Always a Marine” for clothing because it would be perceived as an informational slogan “to express support, admiration or affiliation with the Marines”). *See also In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *1 (TTAB 2020) (“Widely used commonplace messages are those that merely convey ordinary, familiar concepts or sentiments and will be understood as conveying the ordinary concept or sentiment normally associated with them, rather than serving any source-indicating function.”); *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (sustaining opposition to registration of I ♥ DC for clothing because it would be perceived as “an expression of enthusiasm, affection or affiliation with respect to the city of Washington, D.C.”); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1460-61 (TTAB 1998) (affirming refusal to register “Drive Safely” for automobiles because it would be perceived as an everyday, commonplace safety admonition). “The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark.” *In re Eagle Crest*, 96 USPQ2d at 1229. *See also In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1153 (TTAB 2019) (“Common use of a phrase by third parties merely for the purpose of conveying information makes it less

likely that the public will perceive it as identifying a single commercial source and less likely that it will be recognized by purchasers as a trademark.”).

Whether the applied-for-mark JUST ANOTHER DAY IN PARADISE is inherently capable of functioning as a mark for Applicant’s goods depends on whether the relevant public, i.e. purchasers and potential purchasers of Applicant’s goods, would perceive the phrase as identifying Applicant’s goods and their source or origin. *See, e.g., In re Texas With Love, LLC*, 2020 USPQ2d 11290, at *2 (TTAB 2020); *In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *1-2 (TTAB 2019) (“The key question is whether the asserted mark would be perceived as a source indicator for Applicant’s [goods or] services.”); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) (“[T]he critical inquiry is whether the asserted mark would be perceived as a source indicator.”); *In re Volvo Cars*, 46 USPQ2d at 1459 (“A critical element in determining whether a term or phrase is a trademark is the impression the term or phrase makes on the relevant public.”). To make this determination we look to the evidence of record showing how the designation is actually used in the marketplace. *In re Eagle Crest*, 96 USPQ2d at 1229. *See also In re Hulting*, 107 USPQ2d at 1177.

Because the application involved here was filed on an intent to use basis, the record does not include evidence of Applicant’s use. There is, however, evidence of third parties using the applied-for-mark in media,³ and on a range of home décor,

³ The media uses the Examining Attorney submitted consist of the title of: (1) a Bertie Higgins album released in 1982; (2) a May 2016 episode of THE CREWS; (3) a movie from Trixter Pictures, (4) a blog by “a Catholic homeschooling mother of seven”; (5) a March 2018 article in the TRIBUNE NEWS FOR TODAY’S SENIORS; (6) a book by Katherine Tomlinson published in 2010; and (7) a book by Elizabeth Lowell published in 1985. *See* June 1, 2018 Office Action, TSDR 11-22; March 27, 2020 Final Office Action, TSDR 8 and 18. Applicant also submitted

household goods, and clothing items.⁴ As shown in the following examples, the applied-for-mark is emblazoned on many of the same goods covered by the involved application:



online articles and printouts from Wikipedia, blogs and social media accounts referring to a Phil Vassar song titled JUST ANOTHER DAY IN PARADISE. *See* March 4, 2019 Combined Petition to Revive and Office Action Response, TSDR 14-98; September 27, 2019 Request for Reconsideration, TSDR 16-55. Applicant claims to have a relationship with Mr. Vassar but did not prove that it has any legal connection to Vassar. *In re Mayweather Promotions*, 2020 USPQ2d 11298, at *3 (Applicant asserted but did not submit evidence of a legal connection with Floyd Mayweather, Jr.; “Counsel’s argument is ‘no substitute for evidence.’”) (internal quotations omitted).

⁴ June 1, 2018 Office Action, 4-10; March 27, 2020 Final Office Action, TSDR 5, 9-17, and 19-21; May 18, 2020 Denial of Request for Reconsideration, TSDR 3-11. *See also* March 4, 2019 Combined Petition to Revive and Office Action Response, TSDR 96-98.

The record also shows use of the applied-for-mark to identify two vacation rental listings. March 27, 2020 Final Office Action, TSDR 6-7.

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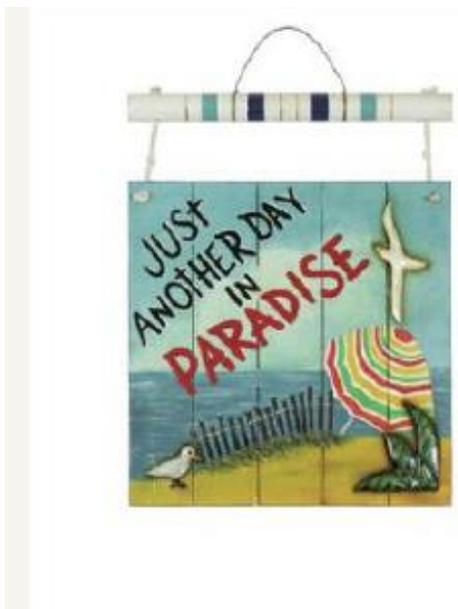
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SIZE

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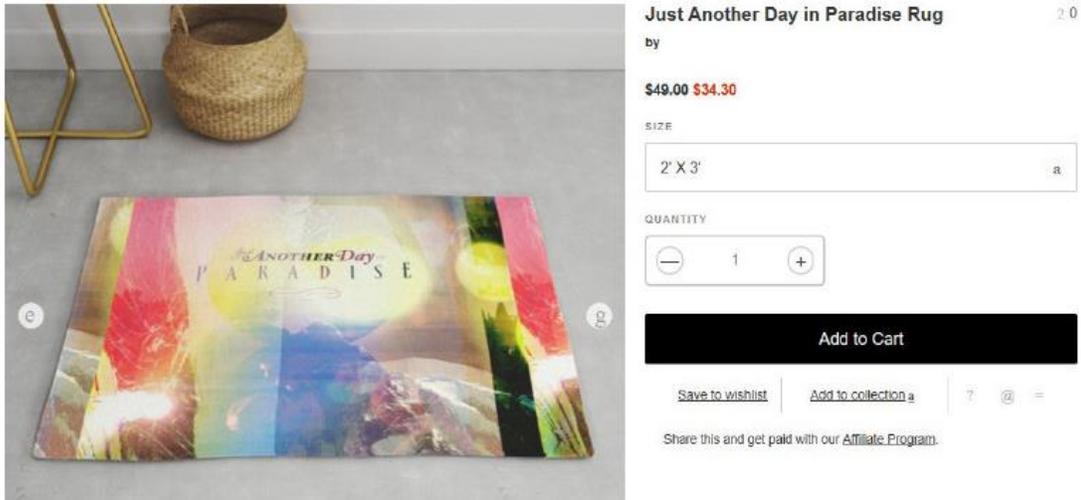
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Prominent ornamental use of an applied-for-mark, as shown in the examples of record, “is probative in determining whether a term or phrase would be perceived in the marketplace as a trademark or as a widely used message.” *In re Mayweather Promotions*, 2020 USPQ2d 11298, at *4; *In re Hulting*, 107 USPQ2d at 1179 (prominent ornamental use tends to be “more consistent with the conveying of an informational message than signifying a brand or an indicator of source.”). *See also D.C. One Wholesaler*, 120 USPQ2d at 1716 (prominent ornamental display of I ♥ DC “itself is an important component of the product and customers purchase the product precisely because it is ornamented with a display of the term in an informational manner, not associated with a particular source”). But this is only one factor relevant to consumer perception. *In re Hulting*, 107 USPQ2d at 1178 (citing *In re Lululemon Athletica Canada Inc.*, 105 USPQ2d 1684, 1689 (TTAB 2013)).

Also pertinent is the nature of the message conveyed by the applied-for-mark. An expression need not convey a specific type of message to be inherently incapable of functioning as a mark. *In re Texas With Love*, 2020 USPQ2d 11290, at *7

("[W]idespread use of a term or phrase may be enough to render it incapable of functioning as a trademark, regardless of the type of message."). But familiar every day expressions and slogans used to convey social, political, patriotic, religious, and laudatory concepts are more likely to be perceived as imparting information than signifying source. *In re Hulting*, 107 USPQ2d at 1179 ("[A]s the record reflects, consumers would not view the proposed mark as an indicator of the source of applicant's goods due to the nature of the political message conveyed."); *Eagle Crest*, 96 USPQ2d at 1229 ("no dispute that the phrase ONCE A MARINE, ALWAYS A MARINE is an old and familiar Marine expression that should remain free for all to use"); *In re Volvo Cars*, 46 USPQ2d at 1460 (finding that the commonly used safety admonition DRIVE SAFELY "should remain in the public domain."); *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (finding THINK GREEN "broadly conveys the ecological concerns of the expanding environmental movement" and this message "would be impressed upon purchasers and prospective customers for applicant's goods"); *In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987) (PROUDLY MADE IN USA not registrable for electric shavers because it would be perceived as expressing a preference for American-made products rather than as a source identifier); *In re Tilcon Warren, Inc.*, 221 USPQ 87, 88 (TTAB 1984) (finding WATCH THAT CHLID for construction materials merely informational because it merely expresses a general concern for child safety).

The evidence here does not demonstrate that the applied-for-mark is used in everyday parlance or that it conveys a common social, political, patriotic, religious or

other informational message. In most of the media examples of record, the applied-for-mark is primarily used as the title of creative works rather than for any apparent common informational message. *Cf. In re Volvo Cars*, 46 USPQ2d at 1458-59 (record included “numerous excerpts from printed publications wherein ‘drive safely’ was used in its everyday, common meaning”); *In re Manco*, 24 USPQ2d at 1942 (“several excerpts” from Nexis database “establish that the slogan ‘THINK GREEN’ is used to signify the need for environmental sensitivity and/or ecological concern in one’s actions”). Moreover, the Examining Attorney has taken the position that the applied-for-mark does not convey any clear or specific message, but rather is subject to a number of different interpretations, namely:

- “taking pleasure in small things”;⁵
- “getting away from one’s troubles”;⁶
- “taking things for granted and being grateful”;⁷
- “getting away for a vacation”;⁸
- “recognizing that one’s self is lucky”;⁹
- “enjoying what life brings to a person”;¹⁰
- “contentment even if things are not perfect”;¹¹ and

⁵ June 1, 2018 Office Action, TSDR 2; March 27, 2020 Final Office Action, TSDR 3.

⁶ March 27, 2020 Final Office Action, TSDR 3.

⁷ *Id.*

⁸ *Id.*

⁹ *Id.*

¹⁰ June 1, 2018 Office Action, TSDR 2.

¹¹ *Id.*

- “living in just the right place for one’s self.”¹²

The potential ambiguity of the applied-for-mark makes it less likely that consumers would perceive it as conveying a particular informational message and distinguishes it from the types of well-recognized and unequivocal expressions found to be incapable of serving as source identifiers. *See, e.g., In re Mayweather Promotions* 2020 USPQ2d 11298, at *6 (evidence indicated PAST PRESENT FUTURE used to convey a familiar concept); *In re Texas With Love*, 2020 USPQ2d 11290, at *3 (TEXAS LOVE conveys “a clear and unequivocal expression” of “pride and love” for Texas); *In re Hulting*, 107 USPQ2d at 1178 (“[T]he phrase [NO MORE RINOS!] is a well-recognized political call to action by a conservative wing of the Republican Party[.]”).

We have recognized, however, that “widespread use of a term or phrase may be enough to render it incapable of functioning as a trademark, regardless of the type of message.” *In re Texas With Love*, 2020 USPQ2d 11290, at *7. Expressions in ubiquitous use are unlikely to be perceived as source identifiers. For example, in *D.C. One Wholesaler* we found that I ♥ DC failed to function as a mark because the market was “awash” in merchandise prominently bearing I ♥ DC as an ornamental feature of the goods sold over a long period of time and by a large number of merchandisers. 120 USPQ2d at 1716. Similarly, in *In re Eagle Crest*, a Google search retrieved nearly 3 million hits for the slogan ONCE A MARINE ALWAYS A MARINE. 96 USPQ2d at 1229. And in *In re Volvo Cars*, the applied-for-phrase DRIVE SAFELY was “uttered

¹² May 18, 2020 Request for Reconsideration Denial, TSDR 2.

on a daily basis, almost automatically with no thought, to others as they drive off in an automobile.” 46 USPQ2d at 1460-61.

The record here supports that consumers and potential consumers have been exposed to use of the applied-for-mark in a non-source-identifying manner on the same and similar goods to those of Applicant. But in our view, use of the applied-for-mark is not sufficiently widespread such that we can find it inherently incapable of serving as a source identifier even though the record does not demonstrate that the applied-for-mark is a familiar expression with a generally understood meaning.

II. Conclusion

The record shows third-party use of JUST ANOTHER DAY IN PARADISE in an ornamental manner on the same and similar types of merchandise identified in the involved application suggesting that the applied-for-mark might not be perceived as a source identifier, but the record as a whole does not establish that the applied-for-mark is a common or familiar expression in such widespread use that it is inherently incapable of functioning as a mark.¹³

Decision: The refusal to register is reversed.

¹³ To be clear, we have not determined that the applied-for-mark functions as a source identifier, but only that the applied-for-mark is **capable** of functioning as a trademark. Our reversal of the failure to function refusal on the ground that Applicant’s mark constitutes a widely used commonplace message does not foreclose the possibility that the applied-for-mark may be refused as ornamentation once specimens of use are submitted with a statement of use.